

REMARKS

Claims 1-22 are pending in this application. By this Amendment, claims 1 and 17 are amended to distinguish over the cited references.

Claims 1, 5, 17, 19, 20 and 21 are amended to further distinguish the claims over Thorne.

No new matter is added by this Amendment. Support for the language added to claims 1, 5, 17, 19, 20 and 21 can be found throughout the specification (e.g., page 24, lines 14-24).

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Nguyen in the September 8, 2005 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

I. Rejection Under 35 U.S.C. §103(a)

A. Cantwell in view Thorne and further in view of Okada

Claims 1-4 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,542,892 ("Cantwell") in view of U.S. Patent No. 5,832,191 ("Thorne") and further in view of U.S. Patent No. 6,307,643 ("Okada"). This rejection is respectfully traversed.

The Patent Office alleges that Cantwell teaches the managing section for managing a mail address for each output printing apparatus, notifying the terminal apparatus of the mail address of the candidate output printing apparatus found in a search by the search section and distinguishing the designated output printing apparatus based on the destination mail address issued from the terminal apparatus. The Patent Office admits that Cantwell does not teach or suggest searching an output apparatus printing apparatus group in response to a search request from a terminal apparatus. Thorne is introduced by the Patent Office as allegedly teaching searching for a printer based on a client request. The Patent Office also admits that Cantwell

does not teach or suggest that the designated output printing apparatus produces printed output. Okada is introduced as allegedly teaching this feature. Applicants respectfully disagree with these allegations.

As discussed in detail during the September 8, 2005 interview, contrary to the Patent Office's assertions, Cantwell does not teach or suggest an information output system as recited in claim 1. Cantwell teaches a system and method for configuring a client, such as a computer, for installation of a printer by using electronic mail ("e-mail"). See, for example, column 1, lines 6-9 and the Title of Cantwell.

In one embodiment of Cantwell, the printer driver is requested by a user of the client by selecting "Printer Installation." This user is then prompted for the e-mail address of the printer to be installed. See column 2, lines 62-65 of Cantwell. The printer server identifies the sender of the e-mail and the sender is checked against a pass list. See column 3, lines 4-7 of Cantwell. This pass list is a list of individuals that are authorized to use that requested printer. See column 2, lines 31-32 of Cantwell.

If the sender is an allowed user, the print server locates the requested print driver. This driver and the capabilities of the printer are packaged into an e-mail and sent back to the client. See column 3, lines 14-20 of Cantwell. The client software receives the e-mail, unpackages the e-mail, installs the driver, and installs a print port on the client. See column 3, lines 21-24 of Cantwell. The client is then ready to print to the requested and newly installed printer. See column 3, lines 25-26 of Cantwell.

Thus, the object of Cantwell is for a user to easily install a printer on their computer by e-mail, without needing to know which print driver is required for the requested printer. See column 3, lines 46-51 of Cantwell.

It is clear from this synopsis that Cantwell does not teach or suggest an information output system having a managing section for managing a mail address for each output

printing apparatus of an output printing apparatus group as recited in claim 1. In fact, Cantwell requires the user to input the e-mail address information for a printer desired to be installed.

Further, Cantwell lacks a search section for searching the output printing apparatus group managed by the managing section in response to a search request having search conditions from a terminal apparatus as recited in claim 1. As explained above, Cantwell does not teach that the user sends a search request having search conditions. Instead, Cantwell teaches that the user directly inputs the desired printer.

Cantwell also lacks a notifying section for notifying the terminal apparatus of the mail address of the candidate output printing apparatus or the plurality of candidate output printing apparatuses found in a search by the search section as recited in claim 1. Instead, Cantwell teaches that the user inputs the information of the printer to be installed. Cantwell does not teach that the client computer is notified of the mail address of the candidate output printing apparatus because the printer is known.

Cantwell further lacks a distinguishing section for distinguishing the designated output printing apparatus from the output printing apparatus group based on the destination mail address of the electronic mail issued from the terminal apparatus as recited in claim 1. Cantwell does not teach or suggest an output printing apparatus group, thus there is no need for a distinguishing section to distinguish the designated output printing apparatus as required in claim 1.

Cantwell merely teaches a system and method of installing a specific printer onto a user client via e-mail. There is no need for the managing section, notifying section and distinguishing section as recited in claim 1 because the specific printer is known to the user from the outset of the process.

Neither Thorne nor Okada remedy these deficiencies. Thorne does not teach or suggest an information output system having a managing section, a notifying section and a distinguishing section as recited in claim 1.

Applicants submit that one of ordinary skill in the art would not have looked to Thorne to remedy the deficiencies of Cantwell, and even if combined, the information output system recited in claim 1 would not have been achieved. In particular, it is not necessary to search an output apparatus group for a candidate output printing apparatus, as allegedly taught by Thorne, in the system of Cantwell because the candidate output printing apparatus is already known to the user.

During the September 8, 2005 interview, Examiners Nguyen and Shah indicated that Thorne alone may teach or suggest the features recited in the claims. Applicants respectfully disagree.

Thorne teaches that when a server receives a printer request from a client/processor, the server causes a search to be made for all printers on the network. See column 4, lines 40-42 of Thorne. A list of all available printers is then provided to the client/processor, and the user must then select one printer for a print job. See column 4, lines 43-46 of Thorne.

However, Thorne does not teach or suggest search sections for searching the output printing apparatus group managed by the managing section in response to a search request having search conditions from a terminal apparatus as recited in claim 1. The term "search conditions" has a particular meaning in the present application. In particular, "search conditions" refers to conditions such as "color print is possible," "double surface print is possible," "the printer is installed in Tokyo," "the printer is within a certain distance from a present location of the terminal apparatus," and the like. See page 24, lines 19-24 of the specification. Thus, the search section searches the output printing apparatus group for

printing apparatus(es) that meet the conditions requested by the terminal apparatus. In contrast, Thorne teaches that a search is made for all printers connected to the network.

Instead, Thorne teaches that the server causes a search to be made of a service registry database, and a list of all printers and their capabilities is then provided to the client/processor, where the user is able to select one printer. In other words, Thorne teaches that the client/processor is provided with a listing of all available printers, not a listing of printers based upon search conditions as recited in claim 1. A user must himself sort through the information on all of the printers on the network and select a suitable printer to use. The list returned in Thorne may very well include printers that are not suitable for printing the required job, but are nevertheless included in the list in Thorne because they are on the network.

Applicants thus submit that Thorne does not remedy the deficiencies of Cantwell. As explained in detail above, Thorne does not teach or suggest a search section for searching the output printing apparatus group managed by the managing section in response to a search request having search conditions from a terminal apparatus as recited in claim 1.

Thorne teaches a method of enabling a new printer to automatically communicate over a network with clients/processors connected to the network. See the Abstract of Thorne. Even if the teachings of Cantwell and Thorne were to have been combined, the achieved method would still merely teach a method for permitting a user to install and use a network printer.

Similarly, Okada does not remedy the deficiencies of Cantwell and/or Thorne. Okada is introduced by the Patent Office as allegedly teaching that the designated output printing apparatus produces printed output as recited in claim 1. Okada relates to a communication result notifying system which notifies the transmission result of repeated facsimile data, received via a LAN, to the e-mail addresses of a facsimile requesting node, a print requesting

node and a manager node. See column 1, lines 9-14 of Okada. Even if combined, the system of claim 1 would not have been achieved.

As described at length above, Cantwell teaches a system and method of configuring a client computer for installation of a printer by using e-mail. In Cantwell, the e-mail sent to the user (not the printer) by a terminal contains the printer driver (assuming the user is authorized to install the printer), not output to be printed. Thus, it is not necessary for the printer taught by Cantwell to print the information in the e-mail from the terminal apparatus because the e-mail merely facilitates the installation of the printer onto the terminal apparatus.

Furthermore, Okada does not remedy the deficiencies of Cantwell and/or Thorne. In particular, Okada does not teach or suggest a search section for searching the output printing apparatus group managed by the managing section in response to a search request having search conditions from a terminal apparatus as recited in claim 1. As is clear from the synopsis of Okada above, it is not necessary for a search section to search output printing apparatus group in response to a search request having search conditions from a terminal apparatus, as required in claim 1. Applicants thus submit that the teachings of Okada as allegedly suggesting printing of the e-mail still would not have suggested the overall system of claim 1.

Thus, Applicants submit that even if combined, the information output system recited in claim 1 would not have been achieved.

Further, claim 22 depends from claim 1. As claims 1-4 are allowable, Applicants submit that claim 22 is similarly allowable.

For the foregoing reasons, Applicants submit that Cantwell, Thorne and/or Okada do not teach or suggest all of the features recited in claims 1-4. Reconsideration and withdrawal of the rejection are thus respectfully requested.

B. Cantwell - Thorne - Okada and further in view of Tanaka

Claims 5-22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Cantwell, Thorne and Okada, and further in view of U.S. Patent No. 6,519,048 ("Tanaka"). This rejection is respectfully traversed.

Applicants note that claim 21 has been rejected under the same rationale as claim 5.

Applicants also note that claims 17-20 have been rejected under the same rationale as claims 1 and 4. As such, Applicants submit that claims 17-20 are allowable for the same reasons as claims 1 and 4, as discussed above.

As described in detail above, Cantwell, Thorne and/or Okada do not teach or suggest an information output system comprising a printer group, a managing section, a search section, an address notifying section, a second server group including a receiving section and a distinguishing section and a converting section as recited in claims 5 and 21.

Tanaka was introduced as allegedly teaching converting information included in the e-mail in accordance with the designated printer. This does not remedy the deficiencies of Cantwell, Thorne and/or Okada. Tanaka does not teach or suggest an information output system comprising a printer group, a managing section, a search section, an address notifying section, a second server group including a receiving section and a distinguishing section and a converting section as recited in claims 5 and 21. The teachings of Tanaka as allegedly suggesting converting the information included in the e-mail still would not have suggested the overall system recited in claims 5 and 21.

For the foregoing reasons, Applicants submit that Cantwell, Thorne, Okada and/or Tanaka do not teach or suggest all of the features recited in claims 5-22. Reconsideration and withdrawal of the rejection are thus respectfully requested.

C. Cantwell - Thorne - Okada - Tanaka and further in view of the well-known feature of checking for a virus in an electronic mail

Claims 14-16 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Cantwell, Thorne, Okada, and Tanaka, further in view of the allegedly well-known feature of checking for a virus in an electronic mail. This rejection is respectfully traversed.

The allegedly well known feature of checking for a virus in an e-mail does not remedy the deficiencies of Cantwell, Thorne, Okada and/or Tanaka. As explained, these references, in combination or alone, do not teach or suggest an information output system comprising a printer group, a managing section, a search section, an address notifying section, a second server group including a receiving section and a distinguishing section and a converting section as recited in claim 5. The allegedly well known feature of checking for a virus in an e-mail would not have suggested the overall system recited in claims 5 and 21.

For the foregoing reasons, Applicants submit that Cantwell, Thorne, Okada, Tanaka and/or the alleged well-known feature of checking for a virus in an electronic mail teach or suggest all of the limitations recited in claims 14-16. Reconsideration and withdrawal of the rejection are thus respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

Leana Levin

James A. Oliff
Registration No. 27,075

Leana Levin
Registration No. 51,939

JAO:LL/tlp

Date: October 17, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
